

REMARKS

I. Summary Of Office Action

Claims 1-35, 37-39, 41-44, 46, and 59-63 are pending in the above-identified patent application.

The Examiner objected to claims 28-31 and 37-39 as being dependent upon a rejected base claim.

The Examiner rejected claims 1-10, 12, 14, 25, 32-35, 59, 60, and 62* under 35 U.S.C. § 102(b) as being anticipated by Culpepper U.S. patent No. 3,861,679 (hereinafter "Culpepper"). Claims 11, 13, and 15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Culpepper in view of Official Notice. Claims 16-24, 26, 27, 41-44, 46, 61, and 63 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Culpepper in view of Garver U.S. patent No. 3,529,823 (hereinafter "Garver").

II. Summary Of Applicants' Reply To Office Action

Applicants have amended claims 1 and 59 to more particularly define the invention. The Examiner's objection and rejections are respectfully traversed.

III. The Rejection Of Claims 1 And 59

The Examiner rejected claims 1 and 59 under 35 U.S.C. § 102(b) as being anticipated by Culpepper. The Examiner's rejection is respectfully traversed.

In applicants' previous Reply to Office Action dated April 21, 2003, applicants argued that Culpepper fails to show

* On pages 2 and 3 of the Office Action, the Examiner also rejected claim 17 over Culpepper. Applicants believe that this was a mistake because the Examiner on page 4 of the Office Action concedes that "Culpepper does not disclose a releasable ball," which is a feature of claim 17 (because claim 17 is dependent from claim 16) and rejects claim 17 over Culpepper in view of Garver. If applicants' belief is incorrect, the Examiner is invited to so state in the next communication.

or suggest a hinge that is attached near the first end of a substantially rigid member as specified by claims 1 and 59. The Examiner in response contends that claims 1 and 59 do not require this feature because "the term 'can be' does not positively recite a limitation in the claim" (May 28, 2003 Office Action, page 6).

Applicants would like to point out that the term "can be" is only used in claim 1, not claim 59. Furthermore, the term "can be" is used in the following context: "a first hinge that can be suspended from a frame." Accordingly, in claim 1 the first hinge is not required to be suspended from a frame. The Examiner, however, appears to be applying the term "can be" to additional features of the claim. While applicants believe that it is improper to apply the term "can be" to additional features of the claim, in order to advance prosecution applicants have amended claim 1 to explicitly limit this term to the feature regarding suspension from a frame. Accordingly, applicants submit that claim 1 as amended requires that the hinge be attached at or near the first end of a substantially rigid member.

With regard to claim 59, applicants believe that the feature of a hinge that is attached near the first end of a substantially rigid member is required. However, in order to advance prosecution, applicants have amended claim 59 to specifically recite that "said hinge [is] attached at or near said upper end."

In stark contrast to applicants' invention, the upper end of rod 13 of Culpepper is not attached to a hinge, but to the ends of springs 11 and 12. See FIGS. 1, 2A, and 2B and col. 2, lines 29-33 of Culpepper. Springs 11 and 12 cooperate to damp out rotational motion of rod 13 about coupler (i.e., hinge) 17, which is attached near the middle of rod 13. Therefore,

Culpepper fails to show or suggest a hinge at or near an end of a substantially rigid member as specified by claims 1 and 59.

Moreover, Culpepper teaches away from locating coupler 17 at or near the end of rod 13. Culpepper requires a significant portion of rod 13 to extend beyond coupler 17 in order for springs 11 and 12 to damp out the rotational motion of rod 13. This aspect of Culpepper is illustrated in FIGS. 2A and 2B. FIG. 2A shows a front view of the apparatus prior to a user striking ball 21. FIG. 2B shows rod 13 at the maximum point of deflection after a user strikes ball 21. As illustrated in FIG. 2B, a significant portion of rod 13 is needed to stretch spring 11 and damp out the motion of rod 13. If a significant portion of rod 13 did not extend beyond coupler 17, then springs 11 and 12 would not be able to effectively damp out the motion of rod 13.

Accordingly, not only does Culpepper fail to show or suggest a hinge at or near an end of a substantially rigid member, but Culpepper also teaches away from locating a hinge at or near the end of a substantially rigid member as specified by claims 1 and 59. For at least these reasons, claims 1 and 59 are allowable over Culpepper. Therefore, applicants request that the rejection of claims 1 and 59 be withdrawn.

IV. The Rejections Of Claims 2-15,
25-27, 32-35, 41-44, 46, And 60-63

The Examiner rejected claims 2-10, 12, 14, 25, 32-35, 60, and 62 under 35 U.S.C. § 102(b) as being anticipated by Culpepper. Claims 11, 13, and 15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Culpepper in view of Official Notice. Claims 26, 27, 41-44, 46, 61, and 63 were rejected under 35 U.S.C. § 103(a) as being unpatentable over

Culpepper in view of Garver. The Examiner's rejections are respectfully traversed.

Claims 2-15, 25-27, 32-35, 41-44, 46, and 60-63 are allowable at least because independent claims 1 and 59, from which claims 2-15, 25-27, 32-35, 41-44, 46, and 60-63 depend, are allowable. Accordingly, applicants request that the rejections of claims 2-15, 25-27, 32-35, 41-44, 46, and 60-63 be withdrawn.

V. The Rejection Of Claims 16-24

The Examiner rejected claims 16-24 under 35 U.S.C. § 103(a) as being unpatentable over Culpepper in view of Garver. The Examiner's rejection is respectfully traversed.

Claims 16-24 are allowable at least because independent claim 1, from which claims 16-24 depend, is allowable. Moreover, claims 16-24 are allowable for the following independent reason.

Claims 16-24 all include the additional feature that the ball mounting device comprises at least one tubular member that allows for releasable mounting of a ball.

The Examiner concedes on pages 4 and 5 of the Office Action that "Culpepper does not disclose a releasable ball." In order to overcome this deficiency in Culpepper, the Examiner relies on Garver, which shows releasable mounting of a ball. The Examiner, however, has failed to provide the requisite motivation necessary to present a rejection under 35 U.S.C. § 103(a).

In the "Response to Arguments" section of the Office Action, the Examiner's comments suggest that there was a

misperception of applicants' previous arguments.* Applicants did not argue that Culpepper himself was not aware of a releasable ball. Rather, applicants argued that Culpepper teaches away from using a release ball. Therefore, even though a person skilled in the art may be aware of a releasable ball, it would not be obvious for that person to apply the releasable ball to Culpepper because Culpepper teaches away from using a releasable ball.

The purpose of Culpepper's invention is to "result in a desireably smooth and rapid return of the ball to the stroking position" (column 1, lines 65-68). Culpepper improves on prior devices in which "the operator must physically return the ball to the stroking position" (column 1, lines 28 and 29). In addition, Culpepper states that the prior devices "are not adaptable to continuous usage without change of operator position" (column 1, lines 30 and 31). If the releasable ball of Garver were to be employed with the apparatus of Culpepper, the ball would be released from the apparatus when stroked by the user. This would defeat the purpose of Culpepper's invention. Therefore, Culpepper teaches a person skilled in the art not to use a releasable ball.

The Examiner contends it would have been obvious to employ "the ball of Garver with the apparatus of Culpepper in order to make the game more enjoyable to play" (Office Action, page 4). The Examiner's contention is respectfully traversed. First, as demonstrated above, Culpepper teaches away from such a combination. Second, Culpepper's apparatus is not used for playing a game. Rather, Culpepper's apparatus is used for

* See applicants' April 21, 2003 Reply to Office Action, page 5.

"practicing and learning the fundamentals of the game of tennis" (abstract of Culpepper).

Third, there is nothing in Culpepper, Garver, or the knowledge generally available to a person skilled in the art to suggest that using a releasable ball with the apparatus of Culpepper would make Culpepper's apparatus more enjoyable. Applicants respectfully submit that the Examiner has failed to fulfill the requirement of presenting an "objective teaching ... or ... knowledge generally available to one of ordinary skill in the art that would lead that individual to combine the relevant teachings of the references" In re Fine, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

Accordingly, because the Examiner has failed to provide the requisite motivation to combine Garver with Culpepper, and because Culpepper teaches away from such a combination, claims 16-24 are allowable for this independent reason.

In view of the foregoing, applicants request that the rejection of claims 16-24 be withdrawn.

VI. Objection To Claims 28-31 And 37-39

The Examiner objected to claims 28-31 and 37-39 as being dependent upon a rejected base claim. Applicants note with appreciation the indication of allowable subject matter in claims 28-31 and 37-39, and hereby expressly reserve the right to rewrite those claims in independent form should the base claims not ultimately be allowed.

In view of the foregoing, independent claim 1, from which claims 28-31 and 37-39 depend, is allowable, and therefore claims 28-31 and 37-39 are allowable. Accordingly, applicants request that the objection to claims 28-31 and 37-39 be withdrawn.

VII. Conclusion

In view of the foregoing, claims 1-35, 37-39, 41-44, 46 and 59-63 are in condition for allowance. This application is therefore in condition for allowance. Reconsideration and allowance of the application are respectfully requested.

Respectfully submitted,



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